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APPLICATION NO. 08/578,433	FILING DATE 12/20/95	FIRST NAMED INVENTOR HUANG	ATTORNEY DOCKET NO. L RIC-95-042
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EXAMINER NGO, R

ART UNIT 2731	PAPER NUMBER
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DATE MAILED: 03/20/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/575,433

Applicant(s)

Huang

Examiner

Ricky Ngo

Group Art Unit
2731



☒ Responsive to communication(s) filed on Dec 8, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 4-7, 9-11, 14-17, 19, 20, 22, and 26-37 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 4-7, 9-11, 14-17, 19, 20, 22, and 26-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

IMPORTANT NOTICE

Effective November 16, 1997, the Examiner handling this application will be assigned to a new Art Unit as a result of the consolidation into Technology Center 2700. See the forth coming Official Gazette notice dated November 11, 1997. For any written or facsimile communication submitted **ON OR AFTER** November 16, 1997, this Examiner, who was assigned to **Art Unit 2603**, will be assigned to **Art Unit 2731**. Please include the new Art Unit in the caption or heading of any communication submitted after the November 16, 1997 date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 11 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by C. Yang, "INETPhone: Telephone Services and Servers on Internet," April 1995, p.p. 1-6.

- Regarding claims 1, 11 and 22, Yang teaches a system and method for providing a phone service through Internet, in which a voice communication (voice signal) is transported to an end user via an Internet connection (see abstract, page 1). The system taught by Yang was introduced as INETPhone which includes: a local phone networks (e.g. circuit-switched network) for locally switching digital signals at each respective user in response to voice input (see page 1,

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line 2); the Internet (packet-switched network) for carrying the digital signals in form of TCP/IP packet format (page 1 line 2); and INETPhone servers¹ (e.g. gateway computer) for converting between the digital signal format and the TCP/IP packet format. The signal format conversion can be performed by employing any commercial telephone interface cards available on the market, such that Dialogic's Voice Board (see lines 11-21 of page 3). The service of INETPhone is illustrated by the following scenario: Assuming a user at area A wants to call another user in area B. The user first makes a local call to an INETPhone server in area A. After the connection, the user keys in the remote phone number in area B to the server. Then the server in area A makes a connection to another INETPhone server area B, and requests the remote server to dial, as a local call, the phone number in area B. Therefore, a long distance phone connection between users in area A and B is established via two local phone connections and one Internet connection between two INETPhone servers (see page 2 lines 11-20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

¹The INETPhone server acts as a gateway between the telephone network and the Internet. By definition, the gateway may be used to interface between two incompatible network systems in which code and protocol conversions are performed.

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-7, 9-10, 26-31, 14-17, 19-20, 23 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over C. Yang in view of Bruno et al. (US Patent No. 5,724,355).

- Yang teaches all the aspects of the claimed invention as set forth in the rejection to claims 1, 11 and 22, except fails to specifically show the detailed components of the INETPhone server which includes a buffer for storing the received digital signal or TCP/IP packet prior protocol conversion taken place; rearranging component for rearranging the received packets in order; routing database for storing addresses; and a central control processing unit. Though Yang does not show but these features of the INETPhone server are necessarily implemented therein for signal routing and conversion and have been known in the Internet industry. For instance, Bruno, US Patent No. 5,724,355, discloses a gateway server (125 of Fig. 1) for providing interface between an Integrated Service Digital Network (circuit-switched network, see block 123 of Fig. 1) and an Internet (packet-switched network, see block 130 of Fig. 1). The gateway server (125) is implemented to provide a protocol architecture in which a digital signal received at the server is processed, stored and converted to another signal format, such that TCP/IP for transport the TCP/IP packet onto the Internet and vice versa (see col. 3 line 47 to col. 6 line 54). The gateway server of Bruno further receives the digital signal from a D channel (16 kbps signaling band, see col. 4 lines 16-17) and provide data compression/decompression for increasing the throughput (see col. 7 lines 64-65). Therefore, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to implement the functions of the gateway server (125) of Bruno to the INETPhone server of Yang for provide the transmission of a digital signal responsive to voice over the Internet. As discussed in Yang, Taking advantage of using the Internet to carry digital signal is to avoid long distance charge from a long distance telephone company, thereby reducing cost to users.

Response to Arguments

5. Applicant's arguments filed 12/8/97 have been fully considered but they are not persuasive.

- In page 6 lines 14-22, the applicant argued that there is no teaching in Yang of an gateway computer for converting digital data from a circuit-switched network into packets for routing the packets through a packet-switched network. Examiner respectfully disagrees. Yang teach a gateway, such that the INETPhone server, coupled between a circuit-switched network, such that the local telephone network, and a packet-switched network, such that the Internet. Data being processed in each respective network apparently utilizes a specific protocol type, different from each others, such as ISDN and TCP/IP. The presence of the gateway coupled between thereto is to provide an protocol conversion technique for routing. This is how a conventional gateway does. Yang does disclose the gateway therefore the arguable feature is apparent to one of ordinary skill in the art.

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Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

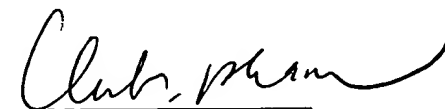
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky Ngo whose telephone number is (703) 305-4798. The examiner can normally be reached on Monday - Friday from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dough Olms, can be reached on (703) 305-4703. The fax phone number for this Group is (703) 305-9509.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Ricky Ngo
March 10, 1998



CHI H. PHAM
SUPERVISORY PATENT EXAMINER
GROUP 2700

3/12/98